

**REMARKS**

Reconsideration of the subject application as currently amended is respectfully requested.

In the Non-Final Office Action dated September 5, 2008, the Examiner requested that the Amendment to the Specification be made by including reference to the prior Italian Patent Application No. UD2004A000007, priority to which is claimed in the corresponding International Application No. PCT/IB05/000105, and, further, that the Certified Priority document of Italian Patent Application be submitted along with the response to above-mentioned Office Action.

It is respectfully submitted that the priority claim has been timely established in the executed Declaration document filed at the time of entering National Stage of the instant application, i.e. on 07/18/2006 (Please see Notice of Application under 35 U.S.C. 371 and 37 C.F.R. 1.495 issued by the DO/EO/US on 06/03/2008 confirming this statement).

The Examiner is respectfully referred to the MPEP §§ 1893.03(c) and 1896. III, respectively, which clearly states that first, the priority document is the document which is placed in the U.S. National Stage application by the International Bureau of WIPO, and if such document is missing in the National Stage application, the Examiner should consult with a Special Program Examiner in his/her Technology Center or the PCT Special Program Examiner.

Further, the MPEP §1896. IV states that claim to prior application must be made in Applicant's Oath or Declaration, as it was done in the instant National Stage application.

In view of the above, it is respectfully submitted that the requirements stated by the Examiner in the Office Action regarding "PRIORITY" has been made in error. A note to this effect is respectfully requested.

In the Non-Final Office Action dated September 5, 2008, the Examiner rejects claims 17-22 and 29-32. The Examiner indicates that claims 23-28 contain allowable subject matter. Applicants respectfully traverse the rejections of claims 17-22 and 29-32 and submit that for at least the reasons discussed below, the claims are allowable in view of the prior art of record.

**Objection to the specification under 37 C.F.R. §§ 1.76 and 1.78**

On page 2 of the present Office Action, the Examiner objects to the specification for failing to comply with 37 C.F.R. §§ 1.76 and 1.78. In response to the Examiner's objection, the first sentence of the specification has been amended to include the chain of continuity of the subject application.

**Objection to the abstract under 37 C.F.R. § 1.52**

On page 3 of the present Office Action, the Examiner objects to the abstract under 37 C.F.R. § 1.52 because "The abstract of the disclosure does not commence on a separate sheet in accordance with 37 C.F.R. § 1.52(b)(4)..."

In response to the Examiner's objection, the abstract is submitted herewith on a separate sheet in compliance with 37 C.F.R. § 1.52(b)(4). No new matter has been added.

**Objections to the drawings under 37 C.F.R. § 1.83**

On page 3 of the present Office Action, the Examiner objects to the drawings under 37 C.F.R. § 1.83 because "...they fail to show in Fig. 4 that 'The annular tooth 31...has a... height H substantially equal to the diameter of the metal wire 10...'"

In response to the Examiner's objection, Applicants hereby amends the drawings to include Fig. 4a. The drawings have been amended to include Fig. 4a in order to illustrate that "The annular tooth 31 is slightly convergent towards the outside and advantageously has a thickness or height H substantially equal to the diameter of the metal wire 10..." as disclosed on page 10, lines 29-33 of the specification as originally filed. No new matter has been added with this amendment. As such, it is respectfully submitted that the amendment to the drawings to include Fig. 4a overcomes the Examiner's objection.

Additionally, the Examiner objects to the drawings because "...the containing element (13) of Figures 2 – 4 is not indicated in Figure 1." In response to the Examiner's objection, Fig. 1 has been amended to include containing element (13). Support for the amendment to Fig. 1 is disclosed, *inter alia*, on page 6, line 18. No new matter has been added with this amendment.

As such, it is respectfully submitted that the amendment to the drawings to include containing element (13) overcomes the Examiner's objection.

Lastly, the Examiner objects to the drawings because "...With respect to element 13 of Figures 2 and 3, said element of Figure 2 is referenced as an 'inner plate' whereas in Figure 3 it is named a 'containing element'..." The Examiner further states that "...Though the designations are analogous, the use of unique terms is questionable..." Applicants respectfully submit that the recitation of containing element and inner plate are general and specific terms, respectively, used to designate the same element. As such, it would be apparent to one of ordinary skill in the art that the inner plate of the mandrel functions as a containing element for containing the first coils of the rolled wire during the beginning of the coil. Therefore, appropriate correction to the specification is not necessary.

Accompanying this Response are replacement drawings in compliance with 37 C.F.R. § 1.121(d).

#### **Objection to the claims**

On page 4 of the present Office Action, the Examiner objects to claim 29 for minor informalities. In response to the objections, claim 29 has been amended in accordance with the Examiner's instructions. No new matter has been added with this amendment.

#### **Rejection under 35 U.S.C. §112 ¶ 2**

The Examiner rejects claims 23-28 under 35 U.S.C. §112 ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

The Examiner rejects claims 23 and 24 under 35 U.S.C. §112 ¶ 2 for insufficient antecedent bases.

In response, claim 23 has been amended to recite "...said annular tooth defining said annular channel at a lower part of said containing element." No new matter has been added with this amendment. Support for this amendment is disclosed, *inter alia*, Fig. 4 of the specification as filed.

Claim 24 has been amended to recite "...wherein said annular tooth includes an outside surface, wherein said annular tooth is slightly convergent towards the outside surface." No new matter has been added with this amendment. Support for this amendment is disclosed, *inter alia*, on page 10, lines 29-31 of the specification as filed.

Lastly, claim 26 is rejected under 35 U.S.C. §112 ¶ 2 because the Examiner asserts that the protrusion is a structure that cannot have a value. The Examiner further states that "...the protrusion comprises a thickness or height of an amount in relation to the diameter of a metal product." Applicants respectfully traverse this rejection because the Examiner concedes that the protrusion comprises a thickness or height. Applicants respectfully submit that if the protrusion comprises a thickness or a height, then the protrusion must have a value or dimension as recited in claim 26.

Additionally, the protrusion comprising a thickness or a height of an amount in relation to the diameter of a metal product is disclosed on page 11, lines 5-7 of the specification as filed. As such, this rejection should be withdrawn because the protrusion of the annular tooth 31 having a length L is disclosed to be between 1.5 and 2 times the diameter of the metal wire 10. Thus, the protrusion of the annular tooth could have a value that is substantially equal to a value of between 1.5 and 2 times the diameter of the metal product as recited in claim 26.

Therefore, withdrawal of the rejection and reconsideration of claims 23-28 is respectfully requested.

**Double patenting rejection**

In response to the double patenting rejection, a terminal disclaimer is attached.

**Rejection under 35 U.S.C. § 103(a)**

Claims 17-22 and 29-32 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,318,660 (hereinafter "Bordignon").

Independent claim 17 as amended recite, *inter alia*, "...a containing element to contain said metal product, arranged in correspondence with said mandrel and including at least a lateral wall at least partially extending substantially orthogonal to said axis, and at least a guide and containing device able to be driven between a first working position in which said guide and

containing device cooperates with said mandrel, and a second inactive position in which said guide and containing device is arranged distant from said mandrel, wherein said lateral wall of said containing element defines, together with an outer surface of said mandrel..."

Applicants respectfully submit that Bordignon fails to teach or suggest each and every element recited in independent claim 17. More particularly, Bordignon fails to teach or suggest the limitation of an angular channel defined by the lateral wall of the containing element and the outer surface of the mandrel.

Contrary to the Examiner's assertion on page 6, paragraph 3, Bordignon is simply silent with respect to an annular channel.

At best, Bordignon in column 4, lines 12-23 only discloses an upper guide 39 that is provided with a mouth 41 through which the rolled stock 12 is suitable to enter into the inner cavities of the guides 39 and 40. Although the guides 39 and 40 disclosed in Bordignon could be interpreted as being the same as flaps 15 and 16 of the subject application, the inner cavity and the mouth 41 of Bordignon, however, is neither the same nor the equivalent of an annular channel defined by a lateral wall of the containing element and the outer surface of the mandrel as recited in claim 17.

As such, claim 17 has been amended to distinguish from the inner cavity and the mouth 41 of Bordignon. With the amendments to independent claim 17 and the arguments presented above, Bordignon fails to teach or suggest any annular channel defined by the inner containing plate, and more particularly, defined between the lateral wall of the inner containing plate and the outer

surface of the mandrel, in order to grip and clamp an initial portion of a metal wire at the beginning of the coiling process.

Independent claim 29 has been amended to recite similar variants of independent claim 17 and therefore includes the arguments discussed above.

As such, it is respectfully submitted that Bordignon fails to teach or suggest independent claims 17 and 29. Claims 18-28 and 30-32 depend on their respective base claims and are therefore also allowable for at least the above reasons.

To expedite prosecution of this application to allowance, the examiner is invited to call the Applicants' undersigned representative to discuss any issues relating to this application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Tiberiu Weisz', with a stylized, flowing script.

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